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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,341	12/31/2001	C. Douglass Thomas	CDTP006D1	3476
7590 C. Douglass Thomas 1193 Capri Drive Campbell, CA 95008			EXAMINER RIMELL, SAMUEL G	
			ART UNIT 2164	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/039,341

Applicant(s)

THOMAS, C. DOUGLASS

Examiner

Sam Rimell

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2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13: Claim 13 has been amended to recite that the searching identifies an “identical” name, as well as a “variant” of the name being monitored. These features are not disclosed in the original disclosure, and are therefore new matter. As understood from applicant’s original disclosure, the system only identifies whether the domain name is actually registered or not registered (steps 910-912 in applicant’s FIG. 9). There are no steps of “identifying identical names” or “identifying variants of the name”. Accordingly, these recited features are new matter.

Claim 14-27: Depend on claim 13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-12 and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider (U.S. Patent 6,338,082).

Claim 1: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a “WHOIS” database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

Since step (314) is performed by a programmed algorithm, the step is performed automatically. Since the step of inputting a search can be performed repeatedly as desired, it is performed periodically. Note that the claim does not specify any aspects of the period, such as whether or not the period is regular or irregular, whether the period is continuously repeated, or how long the period lasts. Accordingly, any repeated action would be periodic.

Claim 2: URLs associated with domain names can be communicated via electronic mail (col. 5, line 38).

Claim 3: The monitored name is a domain name (FIG. 3A, step 306).

Claim 4: A “WHOIS” database is a registry of domain names, and a plurality of such registries exist throughout the world (col. 5, lines 15-24).

Claim 5: Col. 5, lines 40-44 illustrate a domain name as a string of characters (“example.com”).

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Claim 6: FIG. 3A, step 306 establishes that a search is performed for a domain name. Col. 5, lines 40-44 establish that a domain name is a string of characters (“example. com”). Accordingly, the search for the domain name involves a search for a string of characters.

Claim 7: The search of the WHOIS database registries involves searching all entries for matches. Such a search would inherently involve relatively more recent entries and relatively older entries.

Claim 8: FIG. 3A illustrates the generation of a notification message (display record). The display record is displayed to the user who initiated the request, thus the message is forwarded to the requestor.

Claim 9: The WHOIS database inherently contains data on domain name registrant, contact information, and date of registration or update to registration. Examiner has provided a copy of a WHOIS search for “Washington College” as evidence to support this conclusion, although the search results are not being referred to as prior art, since examiner maintains that the claimed features are inherent, rather than obvious.

Claim 10: FIG. 3A, step (306) illustrates receiving a request from a requestor. The request can be made over the Internet using a TCP/IP application (col. 5, lines 5-15).

Claim 11: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a “WHOIS” database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

The displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.

Claim 12: The display of search results from the WHOIS search (step 318) is automated (done without manually searching through all the record). Accordingly, the action of sending a message (displayed results) is done automatically.

Claim 31: The input of the requested name is provided through the Internet (FIG. 1A).

Claim 32: Col. 6, lines 60-64 provide an example of where a template search term is used where the template search term includes both text and the wildcard character "%". Since step (314) is performed by a programmed algorithm, the step is performed automatically. Since the step of inputting a search can be performed repeatedly as desired, it is performed periodically. Note that the claims does not specify any aspects of the period, such as whether or not the period is regular or irregular, whether the period is continuously repeated, or how long the period lasts. Accordingly, any repeated action would be periodic.

Claim 33: See remarks for claim 1.

Remarks

Claim 1 has been amended to recite that the searching is performed automatically and periodically. Examiner maintains that this feature is taught by Schneider. This feature is discussed in the last paragraph of remarks associated with claim 1.

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Claim 11 has been amended to be re-written in independent form. Since the scope of claim has not been substantively changed, the application of the Schneider reference remains applied to this claim.

Claim 13 has been amended to recite new matter, for the reasons specified herein.

Newly added claims 31-33 are anticipated by Schneider for the reasons cited herein.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
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